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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,787	11/07/2000	Benoit Laflamme		4281

7590 09/30/2003
John R Ross III
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EXAMINER

MASINICK, MICHAEL D

ART UNIT	PAPER NUMBER
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2125

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/709,787

Applicant(s)

LAFLAMME ET AL.

Examiner

Michael D Masinick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-138 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 and 94-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 45-93 and 101-138 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. Applicant's arguments filed August 25, 2003 have been fully considered but they are not persuasive.
2. The addition of the claim element regarding "control pages" can be very clearly found in Col 5, lines 24-41. Bassett clearly shows the use of a laptop computer which can be used as a scheduler, user interface, ... and display service for all AIM modules". While not specifically mentioning the word "screen" as stated in the arguments, laptop computers inherently have screens, and Bassett clearly shows the control aspect of the computer.
3. With regards to the amendments to claims 16-20, 32-44 a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the owner, operator, and intended users of the computer system have no bearing on the invention as claimed, thus no weight is given to these claim limitations.
4. Rejections of claims 1-30 stand as previously written with the addition of the new claim element.

Election/Restrictions

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5. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-44, 94-100, drawn to a remotely controlled spa, classified in class 700, subclass 83.
- II. Claim 45-93, 101-121, 127-138, drawn to spa controller buffers, classified in class 700, subclass 275.
- III. Claims 122-126, drawn to remote software upgrades, classified in class 379, subclass 219.

The inventions are distinct, each from the other because of the following reasons:

6. Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as buffer controller. In the instant case, invention III has separate utility such as software upgrading utility. See MPEP § 806.05(d).

7. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II and III, restriction for examination purposes as indicated is proper.

8. During a telephone conversation with John Ross III on September 20th, 2003 a provisional election was made without traverse to prosecute the invention of group I, claims 1-44, 94-100. Affirmation of this election must be made by applicant in replying to this Office action. Claims 45-93, 101-138 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

9. Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, “wherein said wherein said” is not a valid preamble. Appropriate correction is required.

10. Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, claim 1 must be stated as a spa system in order for this claim to be valid. As it currently stands, the spa cannot be multiple spas.

11. Claims 94-100 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, claim 94 states “A Control System as defined in claim 40”. Neither claim 40, nor any of the claims on which it is dependant claim a “control system”.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4-6, 11-13, 16-20, 23, 27, 28, 30, and 32-44 are rejected under 35

U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,706,191 to Bassett et al.

3. Referring to claims 1 and 30, Bassett shows a remotely controlled and monitored spa comprising: a spa controller (Col 1, lines 26-34), an interface signal converter, electrically connected to said spa controller ("AIM", Col 6, lines 5-20); and a remote computer connected to said interface signal converter via a communications link (Figure 15, note that HVAC is an example used in this figure), wherein said remote computer is programmed to display a control page (Col 5, lines 24-41), and wherein said interface signal converter converts communication signals transferred from said remote computer via said communications link and directs the converted signals to the spa controller, and wherein said interface signal converter converts signals from the spa controller to be communicated to said remote computer via said communications link (Col 6, lines 14-20).

4. Referring to claims 4-6, Bassett shows where the interface signal converter comprises an IR or RF transceiver and is capable of transceiving at least two different types of signals.

Examiner notes that these AIMs are designed to run on the CEBus system shown in column 1, lines 46-60 and would inherently be able to transceive all communications available on such a system.

5. Referring to claims 11 and 12, Bassett shows where the remote computer is connected to the interface by wired or wireless technology (IR, RF, or Twisted Pair – Col 1 lines 46-60).

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6. Referring to claim 13 and 21, Bassett shows a second computer for sending commands to said spa controller and receiving data from said spa controller wherein said second remote computer is connected to said spa controller via a computer network. Examiner notes that modems are used to connect computers to computer networks. Therefore any computer in the world which contains a modem with access to a telephone line has the ability to connect to the spa controller and could qualify as a second computer.

7. Referring to claims 16-20, Bassett shows the the remote computer and control pages (Col 5, lines 33-41). Anyone, including the spa owner, spa dealer, spa manufacturer, spa service technician, or spa controller manufacturer, would have access to the system when given the correct authorization.

8. More specifically, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

9. Referring to claim 23, Bassett shows where the computer network comprises a LAN. Examiner notes that a simple twisted pair connection between two microcomputers, like the one shown above, is considered to be a Local Area Network.

10. Referring to claim 27, Bassett shows where the remote computer is connected to a computer network (Examiner notes that modems are used to connect computers to computer networks. Bassets use of a modem in column 5 as shown above therefor reads on this claim).

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11. Referring to claim 28, Bassett shows where the remote computer is used to monitor and control the spa (Col 6, lines 14-19).

12. Referring to claims 32-44, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the owner, operator, and intended users of the computer system have no bearing on the invention as claimed, thus no weight is given to these claim limitations. All technical elements of these claims have been clearly shown in previous rejections.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2-3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,706,191 to Bassett et al in view of U.S. Patent No. 5,877,957 to Bennett.

14. Bassett does not specifically show the use of a RS-485 transceiver in the interface signal converter alone or as one of two different types of communications.

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15. Bennett shows an appliance control system in a home automation environment. In Column 20, lines 1-9, Bennet shows that in addition to CEBus, X-10, and other home automation protocols, RS-485 may also be used.

16. It would have been obvious to one of ordinary skill in the art at the time of invention to use a RS-485 transceiver in the AIM of Bassett because it is another commonly used protocol in the computer networking industry as shown by Bennett.

17. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,706,191 to Bassett et al in view of U.S. Patent No. 6,459,959 to Williams et al.

18. Bassett does not specifically show that the interface signal converter can be removable, secured, or fits into a cavity.

19. Williams shows an irrigation system with removable station modules for watering. Because of the damp conditions, these modules may be attached with screws as shown in figure 4, or a removable bracket as shown in figure 5. Figure 7 shows a cavity where the controller module would be placed.

20. It would have been obvious to one of ordinary skill in the art at the time of invention to use the removable modules and cavity of Williams in the spa control system of Bassett because they share the same problem of dampness and wet conditions. It would have been obvious to one looking to solve this problem to look in any art where large amounts of water are involved.

21. Claims 14, 15, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,706,191 to Bassett et al.

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22. Bassett does not show that the computer network can be the internet.

23. Bassett does show the use of a modem for connection to a network.

24. It would have been obvious to one of ordinary skill in the art at the time of invention to connect the network of Bassett to the internet using any standard protocols such as TCP/IP.

Internet controlled devices and web pages that control household devices are well known in the art.

25. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,706,191 to Bassett et al in view of US Patent No. 5,764,639 to Staples et al.

26. Bassett does not show that the remote computer is a PDA or a cellular phone.

27. Staples shows that in column 4, lines 23-35, the use of a PDA or cellular phone to connect to a communications system.

28. It would have been obvious to one of ordinary skill in the art at the time of invention to use the PDA and Cellular phone of Staples as the remote computers in Bassett because they are smaller and easier to carry than a laptop computer as specified but can provide the functionality.

29. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,706,191 to Bassett.

30. Bassett does not specifically say that the remote computer can be located underneath a spa skirt.

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31. It would have been obvious to one of ordinary skill in the art at the time of invention, when looking for a place to hide the remote computer, to place the computer under a spa skirt in near proximity to the spa controller.

32. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,706,191 to Bassett.

33. Bassett does not specifically say that the remote computer can be used to download software to the spa controller.

34. As shown in reference to claims 14, 15, and 22 above, the internet could easily be connected to the system of Bassett. It is well known in the art that the internet can be used to download related software, and that this can be done in an automated fashion. It would have been obvious to one of ordinary skill in the art at the time of invention to use the remote computer to download related software via the internet to the spa controller.

Conclusion

35. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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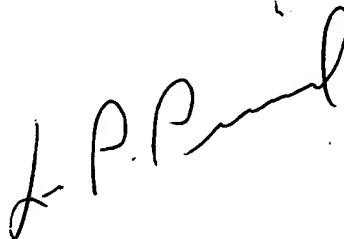
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael D Masinick whose telephone number is (703) 305-7738. The examiner can normally be reached on Mon-Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on (703) 308-0538. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7239 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

mdm
September 24, 2003

A handwritten signature in black ink, appearing to read 'L. P. Picard', is written diagonally across the page.

**LEO PICARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100**